

Remarks

In the Office Action dated 01/11/2008, claims 14-17, 73-79, and 81-84 were rejected under 35 USC §102(e) as being anticipated by Cohen (U.S. Pat. 6,236,330). Claims 22-23 were rejected under 35 USC §103(a) as being unpatentable over Cohen in view of Official Notice. Claims 18-19 were rejected under 35 USC §103(a) as being unpatentable over Cohen in view of Cragun (U.S. Pat. 5,504,675). Applicant respectfully traverses the rejections for at least the reasons set forth below.

Applicant respectfully maintains that the Office's reliance on Cohen '330 as a §102(e) reference is erroneous. As noted in the Amendment and Response filed by Applicant on 01/11/2007 and in the Response filed by Applicant on 10/16/2007, all of the claims of the present application are entitled to an effective filing date of 04/28/1999. The teachings of Cohen '330 relied upon by the Office are not entitled to a reference date that predates 10/12/1999 unless the Cohen Parent (Cohen '993) provides adequate support for such teachings in accordance with 35 U.S.C. §112. See MPEP 2136.03.

In order to rely upon an earlier §102(e) effective date that corresponds to the filing date of an earlier filed application ("parent"), the Office must go through each of the following steps:

- (1) Cite passages in the reference patent where each claim limitation is found; and
- (2) Cite passages in the parent that provide adequate 35 U.S.C. §112 support for *each and every instance* of subject matter relied upon in the reference patent.¹

In order to satisfy the written description requirement under 35 U.S.C. § 112, as required under step (2) above, the Office must show that the prior application "convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention."² Any subject matter in Cohen '330 that the inventor was not in possession of as of the earlier filing date of the Cohen Parent (Cohen '993) cannot be cited against Applicant, even if such relied-upon subject matter in Cohen '330 seems minute.

¹ See *Ex Parte Traversat et al.* (Appeal 2007-2225, Application 10/054,809, decided August 31, 2007, at p. 8). *Ex Parte Traversat* was discussed in detail in Applicant's response filed 10/16/2007.

² *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (emphasis in original).

In addition, under step (2) noted above, if the text or drawings in the later filed application is not identical to the text or drawings in the earlier filed application, the Office must provide “an explanation why the [earlier filed application] would still be recognized by the artisan as providing support.”³ Particularly, with regard to the explanation required of the Office, “mere reference to the text or drawings . . . is not sufficient.”⁴

Under the above standards, Applicant respectfully submits that the Office has failed to satisfy its burden to produce a factual basis establishing that the subject matter of Cohen ‘330 relied upon by the Office is properly supported by the Cohen Parent (Cohen ‘993). Accordingly, the present rejections could not be sustained on an appeal, and should therefore be withdrawn.

In rejecting claims 14-17, 73-79, and 81-84, the Office has relied on col. 5, lines 5-12 of Cohen ‘330, which states:

Further the advertiser 28 may access a station via a communications link 28, e.g. on-line through a modem to a web site, via E-mail, etc., for message content and scheduling. The station communicates such information directly to the controller 16 via the link 26 or to the transporter 12 via the link 27 with the transporter programming the controller 16. The communications link 27 may be a cellular, voice, wireless, non voice, e.g. pager message, or wired telephone.

In accordance with the standards discussed above, in order to rely upon the earlier §102(e) effective date of the Cohen Parent (Cohen ‘993), the Office must cite passages in the Cohen Parent (Cohen ‘993) that provide adequate 35 U.S.C. §112 support for the above-quoted portion of Cohen ‘330. In addition, the Office must provide an explanation as to why a person of ordinary skill in the art would recognize the Cohen Parent (Cohen ‘993) as providing 35 U.S.C. §112 support for the quoted subject matter in Cohen ‘330.

In an attempt to satisfy the first requirement discussed above, the Office has stated as follows:

³ *Ex Parte Traversat et al.* at p. 8. While *Ex parte Traversat, et al.* involved the issue of whether a published patent application was entitled to a critical reference date equal to the filing date of earlier provisional applications that the published application claimed priority to, the same principles of law articulated by the BPAI in that case would apply to the issue of whether an issued CIP patent is entitled to a critical reference date equal to the filing date of an earlier non-provisional patent application that the CIP patent claimed priority to.

⁴ *Ex Parte Traversat et al.* at p. 8.

[T]he Cohen '993 patent clearly teaches an electronic system for communicating with advertisers, as taught by col. 5, lines 21-23 of the '993 patent. Advertisers 28 communicate with the system via a network to receive e-mail and the like and therefore it is clear that there's electronic communication with the advertiser 28. In the '993 patent, the system has to receive messages from advertisers 28 in order for the advertisers 28 to be billed and to choose the advertisements that they want to promote (col. 2, lines 58-61).

(see Office Action dated 01/11/2008 at p. 5). Applicant will address each of the portions of the Cohen Parent (Cohen '993) that are relied upon by the Office, in turn.

Applicant respectfully submits that the first portion of the Cohen Parent (Cohen '993) cited by the Office, namely col. 5, lines 21-23, does not provide adequate support under 35 U.S.C. §112 demonstrating that the inventor was, at the time the Cohen Parent (Cohen '993) was filed, in possession of a system configured to allow an advertiser to "access a station via a communications link," as disclosed in the sections of Cohen '330 relied upon by the Office. In particular, col. 5, lines 21-23 of the Cohen Parent (Cohen '993) states: "The advertiser billing is transmitted to an advertiser 28 via conventional mail, E-mail, facsimile or other means." To the extent that this portion of the Cohen Parent (Cohen '993) very briefly mentions *billing* information being transmitted *from the system to the advertiser*, it does *not* mention anything at all regarding message content or scheduling being performed *by an advertiser*. In addition, this portion of the Cohen Parent (Cohen '993) is limited to one-way communication *from* the system *to* the advertiser, and does not describe any communication from the advertiser to the system or two-way communication between the system and the advertiser.

The Office argues that this portion of the Cohen Parent (Cohen '993) "clearly teaches an electronic system for communicating with advertisers. Advertisers 28 communicate with the system via a network to receive e-mail and the like and therefore it is clear that there's electronic communication with the advertiser 28." (see Office Action dated 01/11/2008 at p. 5). However, even if the Office's statement is true, which Applicant does not concede, and the Cohen Parent (Cohen '993) "clearly teaches an electronic system for communicating with advertisers," that alone does not provide adequate 35 U.S.C. §112 support regarding a system configured to allow an advertiser to "access a station via a communications link ... for message content and scheduling." As discussed above, the Cohen Parent (Cohen '993) at most describes one-way communication from the system to the advertiser regarding billing and does not make any

mention at all regarding communication from the advertiser to the system or communications regarding message content and scheduling, both of which are disclosed by the section of Cohen '330 relied upon by the Office.

Similarly, Applicant respectfully submits that the second portion of the Cohen Parent (Cohen '993) cited by the Office, namely col. 2, lines 58-61, also does not provide adequate support under 35 U.S.C. §112 demonstrating that the inventor was, at the time the Cohen Parent (Cohen '993) was filed, in possession of a system configured to allow an advertiser to "access a station via a communications link," as disclosed in the sections of Cohen '330 relied upon by the Office. In particular, col. 2, lines 58-61 of the Cohen Parent (Cohen '993) states: "A still further aspect of the present invention is to provide a mobile display system of the general character described wherein specific advertisements are displayed when and where the advertisers choose." To the extent that this portion of the Cohen Parent (Cohen '993) refers to the advertisers choosing time and location for specific advertisements, this excerpt does not even discuss *how* those choices are made, *how* those choices are communicated to the system, or *who* is responsible for accessing the system and communicating those choices. Such a vague reference clearly does indicate to a person of ordinary skill in the art that the inventor was "in possession" of a system configured to allow an advertiser to "access a station via a communications link ... for message content and scheduling" as of the filing date of the Cohen Parent (Cohen '993) as required by 35 U.S.C. §112.

The Office further argues that, based on this portion of the Cohen Parent (Cohen '993), "the system has to receive messages from advertisers 28 in order for the advertisers to be billed and to choose the advertisements they want to promote" (see Office Action dated 01/11/2008 at p. 5). Applicant recognizes that if an advertiser is going to choose a time and place for a specific advertisement, that choice would need to be communicated to the system in some manner. However, that alone does not provide adequate 35 U.S.C. §112 support for a system configured to allow an advertiser to "access a station via a communications link ... for message content and scheduling." Based on the cited portion of the Cohen Parent (Cohen '993), the choice could be communicated to the system in any number of ways and by anyone, including someone other than the advertiser. For example, the advertiser may use regular U.S. mail to send in the time and place selection to a company. Then, a representative of the company may access the system

and input that time and place selection. In this scenario, the advertiser may not have any access at all to the system, but his choice could still be communicated to the system. The cited portion of the Cohen Parent (Cohen '993) is simply too vague and does not provide enough detail to satisfy the requirements of 35 U.S.C. §112 with regard to the portion of Cohen '330 relied upon in the rejections.

A comparison of Figure 4 in the Cohen Parent (Cohen '993) with Figure 4 in Cohen '330 and the related description in each reference further supports the conclusion that the Cohen Parent (Cohen '993) does not provide adequate support under 35 U.S.C. § 112 for the portions of Cohen '330 relied upon by the Office in the rejections. In particular, the Office relies upon a portion of Cohen '330 that states: "the advertiser 28 may access a station via communications link 29." The only communications link discussed in the Cohen Parent (Cohen '993) is "communications link 26," which allows communication between the *station* and the *controller* (see col. 4, lines 30-40 and Figure 4). There is absolutely no mention of a communications link between the advertiser and a station in either Figure 4 or the specification of the Cohen Parent (Cohen '993), let alone sufficient description to satisfy 35 U.S.C. § 112. To the contrary, Figure 4 in Cohen '330 depicts two additional communications links that are not present in Figure 4 of the Cohen Parent (Cohen '993). Communications link 27 allows for communication between station 20 and transporter 12 (see Cohen '330 col. 4, line 66 – col. 5 line 12, col. 6, lines 2-4, and Figure 4). Communications link 29 allows for communication between advertiser 28 and station 20 (see Cohen '330 col. 5, lines 5-8 and Figure 4). If these additional communications links were described and supported in the Cohen Parent (Cohen '993) why weren't they depicted in Figure 4 of the Cohen Parent (Cohen '993)? Due to the fact that the original Figure 4 and the specification in the Cohen Parent (Cohen '993) fail to even mention these additional communications links, including communications link 29 between the advertiser 28 and station 20, this is clearly new subject matter and therefore only entitled to a reference date equivalent to the actual filing date of Cohen '330.

As mentioned above, the Office has also failed to provide "an explanation why the [earlier filed application] would still be recognized by the artisan as providing support if not 'word for word' the same as the later text or drawings" as required by *Ex Parte Traversat*.

Unless and until the Office provides such an explanation, a rejection based on the previously cited sections of Cohen '330 cannot be sustained.

In view of the foregoing, Applicant maintains that the subject matter of the Cohen '330 patent relied upon in rejecting the claims of the present application is not prior art against any of those claims. Because the rejections in the Office Action dated 04/19/2007 improperly rely on Cohen '330 as prior art, they cannot be sustained. Applicant therefore respectfully requests that the rejections be withdrawn.

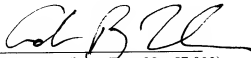
Conclusion

To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513) 369-4811 or via e-mail at aulmer@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,



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